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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,502	06/19/2001	Jeffrey A. Bedell	53470.003037	8691

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EXAMINER

HUYNH, CONG LAC T

ART UNIT PAPER NUMBER

2178

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,502

Applicant(s)

BEDELL ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 11/16/05 to the application filed on 6/19/01.
2. Claims 1-28 are pending in the case. Claims 1, 6, 14, 21 are independent claims.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3, 6, 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 10 of copending Application No. 09/883,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding independent claim 1, '303 discloses:

a prompt object comprises:

- a question to be asked of a user
- at least one validation property

where the prompt object is used to create a report in a computer-implemented reporting system

'303 does not disclose:

- the prompt object is an object separate from the report such that the prompt object may be used more than once in a single report or may be used in more than one report

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified '303 to incorporate the feature that the prompt object is separate from the report and can be used in more than one report since in programming an object normally is defined to be reused, which means being used more than once.

Regarding independent claim 6, '303 discloses:

- specifying one or more of the template or filter properties with a prompt object wherein the prompt object comprises a question to be asked
- at least one validation property
- the prompt object further comprises a default answer to the question

'303 does not disclose:

- selecting a template with one or more template properties

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- selecting filter with one or more filter properties
- the prompt object is an object separate from the report and separate from the one or more template or filters such that the prompt object may be used more than once in a single report or may be used in one or more than one report

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have included in '303 said selecting steps since the specifying step in '303 implies that when specifying the template or the filter as claimed, the template or the filter must be selected to be specified.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified '303 to incorporate the feature that the prompt object is separate from the report and can be used in more than one report since in programming an object normally is defined to be reused, which means being used more than once.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-28 remain rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al. (US Pat App Pub No 2002/0069207 A1, 6/6/02, filed 12/6/00).

Regarding independent claim 6, Alexander discloses:

- selecting a template with one or more template properties ([0006]-[0008], [0040]: generating a report based on a selected survey where a report has format properties such as full, brief, specific question, and statement, and each report when applied the selected format is considered a template for filling data from the survey)
- selecting a filter with one or more filter properties ([0040]: when selecting one of the format properties, the data included in the report is filtered to be included only data required by the selected format)
- specifying one or more of the template or filter properties with a prompt object ([0024], [0040]: each formatted report is selected to comply with the selected survey)
- wherein the prompt object comprises:
 - o a question to be asked of a user (figure 2, [0006]-[0009])
 - o at least one validation property ([0030]: assigning different types of answers to each question in a survey implies a validation of data type for the answer to the question in the survey)

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- wherein the prompt object is used in creating a report to be executed in a reporting system, wherein the report may specify a prompt object as a property of the report, and wherein the prompt object is an object separate from the report such that the prompt object may be used more than once in a single report or may be used in more than one report ([0008]-[0009], [0029], [0034]: the survey, which is considered the prompt object can be reused more than once in a single report or may be used in more than one report)

Regarding claim 7, which is dependent on claim 6, Alexander discloses that the prompt object further comprises a prompt type and wherein at least one validation property comprises verification that the answer provided to the question is of the specified prompt type (0030): assigning different types of answers to each question in a survey implies a validation of data type for the answer to the question in the survey).

Regarding claim 8, which is dependent on claim 6, Alexander discloses that the prompt object further comprises a default answer to the question (figure 2).

Regarding claim 9, which is dependent on claim 6, Alexander discloses that the prompt object further comprises a meaning that, upon request by a responder to the prompt, provides an explanation of the question (figure 4).

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Regarding claim 10, which is dependent on claim 6, Alexander discloses that the prompt object further comprises a reuse value that indicates whether an answer provided from a previous instance of that prompt object, a default value or a new value is to be used for an answer to the question in the prompt object ([0034]).

Regarding claim 11, which is dependent on claim 6, Alexander discloses specifying a single prompt object for a plurality of properties in the report and wherein upon report execution, the question receives only one answer that is provided to each property for which the prompt object was specified ([0034]-[0035], figure 3: indicating a specific topic of a survey, which is considered a property of the survey, such as medical practice, family history, or social history would cause the report execution to receive only one answer provided to each type of survey, which is considered equivalent a prompt object).

Regarding claim 12, which is dependent on claim 6, Alexander discloses specifying at most one prompt object for a template or filter property ([0040]: specifying at most a survey with a survey ID to generate a report format, which is considered equivalent to a template).

Regarding claim 13, which is dependent on claim 6, Alexander discloses that the template comprises a set of templates properties and the filter comprises a set of filter properties and wherein every template and filter property may be specified as a prompt

object ([0040]: the report format has a set of format properties, and upon selecting one of the format properties, the report is generated so that data included in the report is limited to the requirement of the report format; in other words, a filter with filter property is implied in generating a report).

Claims 1-5 are for a prompt object as mentioned in claims 6-10, and are rejected under the same rationale.

Claims 14-20 are for a processor-readable medium of method claims 6-10, and are rejected under the same rationale.

Claims 21-28 are for a system of method claims 6-13, and are rejected under the same rationale.

Response to Arguments

7. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Applicants address that Alexander is not qualified as prior art in view of the submission of the Declaration (Remarks, page 9).

However, the claim rejection remains since the submitted declaration is not ineffective to overcome the Alexander reference as mentioned in the Response to the Amendment below.

Response to Amendment

8. The declaration filed on 10/2/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Alexander reference.

Regarding the Declaration, it is unclear what Applicants would like to establish: 1) conception coupled with due diligence or 2) reduction to practice prior to the effective date of the reference in the submitted declaration, since both are mentioned in the declaration and in Applicants' remarks. Applicants should consider filing a proper declaration in light of MPEP 715.07 (III) and MPEP 715.07 (a).

In any case, Exhibit A submitted as a written description of the invention, do not constitute an actual reduction to practice or establish conception coupled with due diligence. Furthermore, only the filing of a US patent application which complies with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application, does not qualify as reduction to practice or conception coupled with due diligence.

Accordingly, Applicants have not established prior invention. The rejection is maintained.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Judd et al. (US Pat No. 5,602,982, 2/11/97).

Baggett, Jr. et al. (US Pat No. 6,925,443, 8/2/05, filed 4/26/00).

Borton et al. (US Pat App Pub No. 2001/0047274, 11/29/01, priority 3/21/00).

Donahue (US Pat App Pub No. 2002/0095311, 7/18/02, priority 7/5/00).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
12/22/05